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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RABINDRANATH DUTTA and
KARTHIKEYAN RAMAMOORTHY

Appeal 2009-004459
Application 09/965,003
Technology Center 3600

Decided¹: July 15, 2009

Before MURRIEL E. CRAWFORD, BIBHU R. MOHANTY, and
KEVIN F. TURNER *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants seek our review under 35 U.S.C. § 134 of the Final
Rejections of claims 1-19. We have jurisdiction under 35 U.S.C. § 6(b).

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

SUMMARY OF THE DECISION

We AFFIRM².

THE INVENTION

Appellants' claimed invention relates to a computer product, method, and system for managing patient prescription information wherein a patient's prescription is received at a pharmacy and insurance coverage for the prescription is verified along with an insurance payment category for the prescription. Subsequently, payment is collected from the patient based on the payment category, then the payment category and the payment is transmitted to the insurance company exclusive of the medication information. (Spec. 3).

Independent claim 1, which is deemed to be representative, reads as follows:

1. A method comprising:
 - receiving a patient prescription for a specified medication;
 - verifying availability of insurance coverage from an insurance company for the patient prescription;
 - verifying an insurance payment category for the prescription;
 - collecting a payment from the patient based on the payment category; and

² Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Mar. 10, 2008) and the Examiner's Answer ("Ans.," mailed May 13, 2008).

transmitting the payment category and the payment to the insurance company excluding the medication information.

THE REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Snowden et al.	US 2002/0026332 A1	Feb. 28, 2002
Joao	US 6,283,761 B1	Sept. 04, 2001
Mayaud	US 5,845,255	Dec. 01, 1988

The Examiner rejected claims 1-6 and 8-19 under 35 U.S.C. § 103(a) as being unpatentable over Mayaud, Joao, and Snowden. Additionally, the Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Mayaud and Joao.

Rather than repeat the arguments of Appellants or Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

1. Have Appellants shown that the Examiner erred in rejecting claims 1-6 and 8-19 under 35 U.S.C. § 103(a) as being unpatentable over Mayaud, Joao, and Snowden?
2. Have Appellants shown that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Mayaud and Joao?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by at least a preponderance of the evidence. *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (explaining the general evidentiary standard for proceedings before the Office).

1. Joao is directed to a method which can be an be utilized to create and maintain comprehensive patient databases which can be accessed via a network environment and can provide for the processing, tracking and reconciliation of healthcare claims. (col. 4, ll. 40-47 and col. 6, ll. 49-51).

2. Mayaud is directed to a prescription management system for electronic prescription creation by a prescriber at a point of patient care, said prescription being usable by a pharmacist to dispense drugs. (col. 4, ll. 29-35).

3. Snowden is directed to “a system and method for creating, maintaining and automatically updating a consumer-owned and controlled personal electronic health record. The invention allows consumers to decide how, when and where their medical information is to be accessed and used, resulting in data security becoming an integral part of the process.” ([0002]).

4. Snowden discloses that, “[t]he repository’s medical records, owned and controlled by the individual, may be made electronically accessible in whole or select parts to appropriate care providers, insurers and suppliers.” ([0079]).

5. Snowden describes medical records to include medications. ([0047]).

6. Joao discloses the submission of healthcare claims, forms, and requests upon the conclusion of a doctor's service. This submission triggers coverage under a healthcare insurance policy. (col. 37, ll. 22-30).

7. We interpret the healthcare claims, forms, and requests to contain healthcare codes which are used to procure payment.

8. Snowden discloses a patient authorizing medication information to be released in whole or in part to emergency personnel. ([0107]).

9. Snowden's repository makes personal medical records which are owned and controlled by the individual patients accessible in whole or in part to appropriate third parties. (Abs.)

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

In *KSR*, the Supreme Court held that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417.

The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *In re Oetiker*, 977 F.2d at 1445. *See also In re Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *Id.*

ANALYSIS

Claims 1-6 and 8-19³ as being unpatentable over Mayaud, Joao, and Snowden.

Independent claim 1

Appellants argue that the combination of Mayaud, Joao and Snowden does not disclose or describe "transmitting the payment category and the payment to the insurance company excluding the medication information." (Br. 11). We are not persuaded by Appellants' arguments and find that a person with ordinary skill in the art would have been able to use the teaching in Snowden, which discloses that an individual's medical records, including medication information, may be made electronically accessible in whole or in part to a requester (FF 4, 5). Additionally, we find that a person with ordinary skill in the art would have been able to apply this selective exclusion of data technique to any type of data transmission including the transmission of payment category and payment to the insurance company disclosed in Joao. (FF 6, 7). This modification is nothing more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement. *See KSR*, 550 U.S. at 417. Specifically, the modification involves the mere application of a known technique which here is the exclusion of medication information. We conclude that this modification would have been obvious to one of ordinary skill in the art the time of the

³ We note claim 18 is not written as a proper dependent claim since it does not depend upon another claim. (Br., Claim Appendix).

invention and thus appears to be merely a predictable variation of the transmitting the payment category and the payment to the insurance company disclosed in Joao. Accordingly, we find this argument unpersuasive.

Additionally, Appellants argue that, in Snowden, “. . . the selectively withheld information is personal information related to a medical history rather than medication information and the reasons for withholding personal information do not apply to the exclusion of medication information.” (Br. 11-12). We are not persuaded by Appellants’ arguments and find that as discussed *supra*, Snowden discloses making medical records accessible in whole or in part to insurers. (FF 4). These medical records include medical information including medication records. (FF5). A person of ordinary skill in the art would have appreciated from a reading of Joao and Snowden, that when transmitting the payment category and the payment to the insurance company, the transmission could be in whole or in part, thereby excluding medication information or any other type of information. Thus, a person of ordinary skill in the art would have known this from Snowden and applied this technique to Joao when transmitting the payment category and the payment to the insurance company. Accordingly, we find this argument unpersuasive.

Appellants also argue that allowing access to information stored in a database is different than whether information is excluded from a transmission made in conjunction with a payment request, which is all that Joao teaches. (Br. 12). However, we agree with the Examiner that Joao teaches many aspects that can be considered transmitted “payment

categories,” that Joao provides for payment for services rendered, and taken with Snowden, certain information can be excluded. (Ans. 9-10).

Accordingly, we find this argument unpersuasive.

Claims 2 6, and 8-19⁴

The Appellants do not separately argue claims 2-6 and 8-19, and so has not sustained its burden of showing that Examiner erred in rejecting claims 2-6 and 8-19 under 35 U.S.C. § 103(a) as unpatentable over Mayaud, Joao, and Snowden for the same reasons we found as to claim 1, *supra*.

Claim 7 as being unpatentable over Mayaud and Snowden⁵.

Independent claim 7

Appellants argue that Joao does not suggest "providing limited access to the prescription information to third parties in response to authorization by the patient.” (Br. 12). We note that Appellants’ arguments are inapposite since the rejection of claim 7 does not cite Joao. Assuming this argument was intended to be made against the actual combination, we are not persuaded by Appellants’ arguments. We find that the prescription information and other medical records in Snowden are owned and controlled

⁴ A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

⁵ Appellants argue claim 7 as being rejected under 35 U.S.C. § 103(a) as being unpatentable over Mayaud, Joao and Snowden, which is not correct. (Br. 10). The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Mayaud and Snowden in the Final Rejection dated August 8, 2007. (Ans. 7).

by the patient. (FF 4, 5). Snowden additionally allows consumers to decide how, when and where their medical information is to be accessed and used. (FF 3). Thus, since the patient controls the prescription information and other medical records in Snowden, it would require an authorization from the patient to have them released in whole or in part to insurers. (FF 8, 9). Further, Appellants have not shown that Examiner erred in finding that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the steps taught in Mayaud with the step of “providing limited access to the prescription information to third parties in response to authorization by the patient” taught by Snowden. Therefore, we find this argument unpersuasive as to error in the rejection.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-6 and 8-19 as being obvious over Mayaud, Joao, and Snowden and in rejecting claim 7 as being obvious over Mayaud and Snowden.

DECISION

The decision of the Examiner to reject claims 1-19 is **AFFIRMED**.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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rvb

cc:

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